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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,432	03/12/2004	Muhammad Chishti	018563-000550US	6231

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EXAMINER

MANAHAN, TODD E

ART UNIT PAPER NUMBER

3732

DATE MAILED: 01/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	10/799,432	CHISHTI ET AL.	
	Examiner	Art Unit	
	Todd E. Manahan	3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>11/09/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2, and 4-8 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 5, and 63 of U.S. Patent No. 6,183,248 in view of Martz (United States Patent No. 4,793,803). Martz discloses a polymeric shell having a wire embedded therein to provide required additional stiffness (see figure 10 and col. 7, lines 4-23). It would have been obvious to provide the positioning appliance of United States Patent No. 6,183,248 with a wire embedded therein in view of Martz in order to increase the stiffness thereof if required.

Claims 1 and 3 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 5 of U.S. Patent No. 6,183,248 in view of Bergersen (United States Patent No. 4,330,272).

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Bergersen discloses a dental appliance comprising a polymeric shell 54 in the shape of an arch having cavities shaped to receive and reposition teeth from a first orientation to a successive orientation and a wire 48 mounted on the polymeric shell to span at least a portion of the arch of the polymeric shell. It would have been obvious to provide the positioning appliance of United States Patent No. 6,183,248 with a wire embedded therein in view of Bergersen in order to increase the stiffness thereof if required.

Claims 1, 2, and 4-8 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,390,812 in view of Martz (United States Patent No. 4,793,803). Martz discloses a polymeric shell having a wire embedded therein to provide required additional stiffness (see figure 10 and col. 7, lines 4-23). It would have been obvious to provide the positioning appliance of United States Patent No. 6,390,812 with a wire embedded therein in view of Martz in order to increase the stiffness thereof if required.

Claims 1 and 3 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,390,812 in view of Bergersen (United States Patent No. 4,330,272).

Bergersen discloses a dental appliance comprising a polymeric shell 54 in the shape of an arch having cavities shaped to receive and reposition teeth from a first orientation to a successive orientation and a wire 48 mounted on the polymeric shell to span at least a portion of the arch of the polymeric shell. It would have been obvious to provide the positioning appliance of United States Patent No. 6,390,812 with a wire embedded therein in view of Bergersen in order to increase the stiffness thereof if required.

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Claims 1, 2, and 4-8 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,485,298 in view of Martz (United States Patent No. 4,793,803). Martz discloses a polymeric shell having a wire embedded therein to provide required additional stiffness (see figure 10 and col. 7, lines 4-23). It would have been obvious to provide the positioning appliance of United States Patent No. 6,485,298 with a wire embedded therein in view of Martz in order to increase the stiffness thereof if required.

Claims 1 and 3 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,485,298 in view of Bergersen (United States Patent No. 4,330,272).

Bergersen discloses a dental appliance comprising a polymeric shell 54 in the shape of an arch having cavities shaped to receive and reposition teeth from a first orientation to a successive orientation and a wire 48 mounted on the polymeric shell to span at least a portion of the arch of the polymeric shell. It would have been obvious to provide the positioning appliance of United States Patent No. 6,485,298 with a wire embedded therein in view of Bergersen in order to increase the stiffness thereof if required.

Claims 1, 2, and 4-8 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,705,861 in view of Martz (United States Patent No. 4,793,803). Martz discloses a polymeric shell having a wire embedded therein to provide required additional stiffness (see figure 10 and col. 7, lines 4-23). It would have been obvious to provide the positioning appliance of United States Patent No.

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6,705,861 with a wire embedded therein in view of Martz in order to increase the stiffness thereof if required.

Claims 1 and 3 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,705,861 in view of Bergersen (United States Patent No. 4,330,272).

Bergersen discloses a dental appliance comprising a polymeric shell 54 in the shape of an arch having cavities shaped to receive and reposition teeth from a first orientation to a successive orientation and a wire 48 mounted on the polymeric shell to span at least a portion of the arch of the polymeric shell. It would have been obvious to provide the positioning appliance of United States Patent No. 6,705,861 with a wire embedded therein in view of Bergersen in order to increase the stiffness thereof if required.

Allowable Subject Matter

Claims 1-8 are allowable over the prior art.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

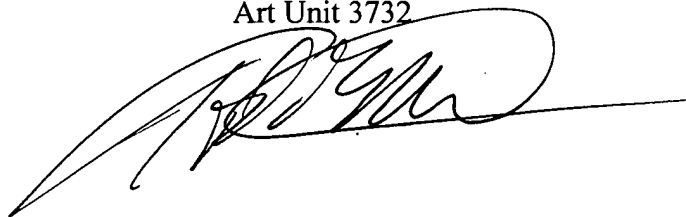
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Todd E. Manahan whose telephone number is 571 272- 4713. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on 571 273-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Todd E. Manahan
Primary Examiner
Art Unit 3732

T.E. Manahan
11 January 2006

A handwritten signature in black ink, appearing to read 'T.E. Manahan', is written over the printed name and title of the examiner.